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10/801,015	03/15/2004	Mark A. Stansbury	27028-6	1017

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/801,015

Applicant(s)

STANSBURY, MARK A.

Examiner

Naschica S Morrison

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>31504</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is the first Office Action for serial number 10/801,015, Furnace Mount and Method of Installation, filed on March 15, 2004. Claims 1-20 are pending.

#### ***Specification***

The disclosure is objected to because of the following informalities: on page 4, line 4 delete “,” after “method”; on page 10, line 9 “material” should be --materials--, on lines 15 and 19 “117” should be --126--, and on line 17 “functioning” should be --functions--. Appropriate correction is required.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “117” has been used to designate both the outer surface of 126 in Figure 1 and the top surface of 111 in Figure 8. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the layer of adherent material (125) must be shown or the feature canceled from the claims. No new matter should be entered. The drawings include the indication of an adherent layer in the form of reference numeral 125; however, figures 6, 8, and 10 do not specifically indicate a

layer of adherent material on top of the vibration dampening material 126. For example, the adherent layer/material 125 shown in Figure 8 should have a cross-sectional thickness; and in Figures 6 and 10, Applicant may wish to show the adherent layer/material 125 as having a textured top surface.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 is rejected because it is unclear whether the combination of the mount and the furnace is being claimed or merely the subcombination of the mount. Claim 19 recites the furnace in a functional statement in the preamble of the respective claim, indicating the subcombination is being claimed, yet the applicant recites a further structural limitation to the furnace in claim 19 (lines 1-2), indicating the combination is being claimed. For purposes of this Office action, the examiner will assume the **subcombination** is being claimed.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 8-10, 14-16, 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of

Art Unit: 3632

U.S. Patent No. D465,022 to Stansbury in view of U.S. Patent 4,842,095 to Rozek.

Regarding claims 1-3, 8, 9, 16 and 20, the claim of D465,022 discloses all of the limitations of the claims but does not teach the pad-like component on top of the main body member being adherent and including an adhesive surface. Rozek teaches a mount comprising a main body member (24) and an adherent component (23, 26) having an adhesive layer/outer surface (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of D465,022 to include an adhesive layer attached to the upper surface of the pad-like component because one would have been motivated to provide a means for securing the mount to the supported object as taught by Rozek. Regarding claims 4 and 10, the claim of D465,022 does not teach the pad-like material being a vibration dampening material. However, Rozek teaches the adherent component including a vibration dampening material (23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pad-like component of D465,022 to be formed of a vibration dampening material because one would have been motivated to reduce the transmission of vibration to and/or from the supported object as taught by Rozek (col. 1, lines 7-12). Regarding claims 14 and 19, the claim of D456,022 does not expressly teach the first and second surfaces of the main body member being at least 2 inches apart; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first and second surfaces to be spaced at least 2 inches apart since it has been held that a change in the size of a prior art device is a design consideration within the skill of the

Art Unit: 3632

art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Regarding claim 15, the claim of D465,022 does not teach the mount being substantially rigid; however it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the mount of a rigid material because one would have been motivated to provide a strong, unyielding mount to protect the supported object from unnecessary movement.

Claims 5-7, 11-13, 17 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of D465,022 in view of Rozek as applied to claims 1-4, 8-10, 14-16, 19 and 20 above, and further in view of U.S. Patent 4,721,275 to Benton et al. (Benton). Regarding claims 5-7, 11-13, 17 and 18, the claim of D465,022 in view of Rozek discloses the mount as applied above, but Rozek does not teach the vibration dampening material being elastomeric and/or cork. Benton discloses a mount comprising a main body member including a vibration dampening material defined by an elastomeric, cork material (col. 2, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the vibration dampening material to be formed of an elastomeric, cork material because one would have been motivated to provide a material having sufficient vibration dampening characteristics as taught by Benton.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3632

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,721,275 to Benton et al. (Benton) in view of U.S. Patent 4,842,095 to Rozek. With regards to claims 1-13, 15, 17, 18, and 20, Benton discloses a mount comprising: a main body member (18 generally) having a first surface (at 14) parallel to and spaced from a second surface (36) and a locating portion including an upstanding member (16) extending perpendicular to the second surface (36); an adherent component (34) parallel and connected to the second surface (36) and located on the upstanding member (16); wherein the adherent component (34) includes a vibration dampening pad defined by an elastomeric, cork material (col. 2, line 7); and wherein the mount includes a means (42) for engaging and coupling the main body member (18 generally) to an object (12). Benton does not disclose the coupling means being an adhesive surface included with the adherent component (34). Rozek teaches a mount comprising a main body member (24) and an adherent component (23,26), wherein the adherent component (23,26) includes a vibration dampening material (23) having an adhesive layer/outer surface (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton by substituting an adhesive layer attached to the upper surface of the adherent component (34) for the coupling means (42) since adhesives, nails, screws, etc. are equivalent for their use in the fastening art and the



Art Unit: 3632

selection of any of these known equivalents to secure the mount to an object would be within the level of ordinary skill in the art.

Regarding claims 14 and 19, Benton does not expressly disclose the first and second surfaces being spaced 2 inches apart or the main body member (18) supporting an object (12) at least 2 inches above the floor. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mount of Benton to be at least 2 inches in height, since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benton in view of Rozek, and further in view of U.S. Patent 2,941,329 to Apparius. With regards to claim 16, Benton in view of Rozek discloses the mount as to claims 1-15 and 17-20 applied above, but Benton does not disclose the locating portion including two upstanding members. Apparius teaches a mount (Figure 2) comprising a main body member (5 generally) and a locating portion, wherein the locating portion includes two upstanding members (8,9) that are oriented perpendicular to one another and each having a bearing surface (see Figure 3 generally) adapted to abut a surface (11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the locating member of Benton to include a pair of perpendicular upstanding members because one would have been motivated to provide a means for firmly holding the supported object as inherently taught by Apparius.

Art Unit: 3632

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benton in view of Rozek and further in view of U.S. Patent 1,887,283 to Brabson. With regards to claim 16, Benton in view of Rozek discloses the mount as to claims 1-15 and 17-20 applied above, but Benton does not disclose the locating portion including two upstanding members. Brabson discloses a mount comprising a main body member (20) having a locating portion comprising two upstanding members (21) that are perpendicular to the main body member and each other. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main body member of Benton to include a second upstanding member perpendicular to the first upstanding member (16) because one would have been motivated to provide a means for a means for firmly holding the supported object against movement as taught by Brabson (pg. 2, lines 12-17).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 1179811 to Diss; 1278432 to Burns; 1278433 to Burns; 1300136 to Diss; 1420602 to Wujek; 1528261 to Noelting; D340638 to Campbell; 6405982 to Ferencz

The references cited above disclose mounts relevant to the present invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's

Art Unit: 3632

supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.



*Naschica S. Morrison*

Patent Examiner

Art Unit 3632

1/11/05



ANITA KING  
PRIMARY EXAMINER